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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RANDALL G. SMITH and TIMOTHY J. MARTEL

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Appeal 2007-3134  
Application 09/746,754  
Technology Center 2800

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Oral Hearing Held: October 24, 2007

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Before JOHN C. MARTIN, HOWARD B. BLANKENSHIP, and  
JOHN A. JEFFERY, Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

SAYED RASHIDI-YAZD  
TROUTMAN SANDERS LLP  
600 PEACHTREE STREET, NE  
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The above-entitled matter came on for hearing on Wednesday,  
October 24, 2007, commencing at 9:00 a.m., at the U.S. Patent and  
Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia,  
before Sean Williams, Notary Public.

1 JUDGE MARTIN: Good morning, counsel.

2 MR. RASHIDI-YAZD: Good morning.

3 JUDGE MARTIN: Let me spell your last name for the court  
4reporter's benefit.

5 MR. RASHIDI-YAZD: R-A-S-H-I-D-I - Y-A-Z-D.

6 JUDGE MARTIN: Thank you. You can proceed whenever you're  
7ready.

8 MR. RASHIDI-YAZD: Good morning, Your Honor. First of all, on  
9behalf of the Appellant, (indiscernible) Corporation, I'd like to thank you for  
10your time to hear our oral argument on this case. Although the briefs, I  
11believe, stand on their own, I think we need to take a little bit of time and  
12hopefully explain the case in a little more detail.

13 Based on how you'd like me to proceed, I can either take questions at  
14the outset or sort of give a background of what we're going after in the  
15claims.

16 JUDGE MARTIN: Proceed.

17 JUDGE JEFFERY: Go ahead.

18 MR. RASHIDI-YAZD: Well, we're lucky today. We have a  
19whiteboard right here, although it's not electronic. As pretty much  
20everyone's aware, a whiteboard is basically a way of providing indicia, for  
21example, to a classroom. So in the case here we have a whiteboard to my  
22right that one could write on with a dry erase marker. Well, unfortunately,  
23you can't copy that, scan it, print it for, for example, an audience or a  
24classroom.

25 We move forward to an electronic whiteboard which has a computer  
26that displays a projector that projects an image onto the surface of the

1electronic whiteboard enabling one to now save indicia that you have stored  
2-- typed onto the whiteboard or touched by the whiteboard surface.

3       In order to sync the computer to the electronic whiteboard, there has  
4to be some type of calibration or a means of being sync or oriented  
5(indiscernible). As a result, we're getting closer to our invention. Our  
6invention is not claiming a calibration system or a method. It is one step that  
7precedes. That happens to be the initiation of the calibration process.

8       This case was originally allowed over the (indiscernible) reference.  
9After some antics from a competitor of ours it was withdrawn. The  
10Examiner has taken the position that a step that comes before what we have  
11defined as the calibration process in our application is sufficient to reject us  
12under 102. We maintain that Step 4 of their 7 step process which is on page  
1327 to 28 of the 1998 Smart Manual that we have referred to is their step of  
14initiation or step that begins the calibration process. The calibration process,  
15as it's claimed in Claim 41, requires three steps, a projection of the GUI or  
16some type of GUI onto the electronic whiteboard surface, a detection of  
17touches of the electronic whiteboard surface, and then some type of  
18calculation or communication between the electronic whiteboard and the  
19computer in order to calibrate the two.

20       JUDGE JEFFERY: But, counsel, let me ask you about the calibration  
21process --

22       MR. RASHIDI-YAZD: Yes, sir.

23       JUDGE JEFFERY: -- as it's defined.

24       MR. RASHIDI-YAZD: Sure.

25       JUDGE JEFFERY: Doesn't the claim, by using the word "includes"  
26-- you say the calibration process "includes," and then you --

1 MR. RASHIDI-YAZD: Which claim are you referring to?

2 JUDGE JEFFERY: -- recite a step. Doesn't that not preclude other  
3steps that aren't necessarily claimed in the calibration process? You're not  
4strictly limited to the steps that you recited in the claim as corresponding to  
5the calibration process.

6 MR. RASHIDI-YAZD: Which claim are you referring to  
7specifically?

8 JUDGE JEFFERY: Well, Claim 41.

9 JUDGE BLANKENSHIP: Claim 41.

10 MR. RASHIDI-YAZD: 41? Okay.

11 JUDGE JEFFERY: In line 3 of Claim 41 --

12 MR. RASHIDI-YAZD: Yes.

13 JUDGE JEFFERY: -- you say now wherein in the calibration process  
14includes --

15 MR. RASHIDI-YAZD: Okay.

16 JUDGE JEFFERY: -- the steps, so on, projecting an image, so on and  
17so forth.

18 MR. RASHIDI-YAZD: Sure.

19 JUDGE JEFFERY: What I'm asking is that certainly -- we're not  
20saying the calibration process "consists of" --

21 MR. RASHIDI-YAZD: Correct.

22 JUDGE JEFFERY: -- these steps so as to provide a narrower  
23recitation of the calibration process. It clearly -- it seems to me, it could  
24include other steps.

25 MR. RASHIDI-YAZD: I agree it could, but the way that we've  
26defined it in the specification via a lexographer, we have defined the

1calibration process to include those three specific steps. On top of it, when  
2this case was originally allowed, the Examiner required that we include  
3those three limitations that identified the calibration.

4 JUDGE JEFFERY: Well, fair enough. Let's go to the definition that  
5you point out --

6 MR. RASHIDI-YAZD: Sure.

7 JUDGE JEFFERY: -- in your briefs.

8 MR. RASHIDI-YAZD: Sure.

9 JUDGE JEFFERY: As I understand it, you're defining the calibration  
10process on -- I think you cited page 5 of the specification. Lines 11 through  
1124 --

12 MR. RASHIDI-YAZD: Yes, sir.

13 JUDGE JEFFERY: -- I think were mentioned.

14 MR. RASHIDI-YAZD: Yes.

15 JUDGE JEFFERY: Is there really an express definition? I  
16understand this is clearly a description of the calibration process for an  
17electronic whiteboard. No problem there.

18 MR. RASHIDI-YAZD: Okay.

19 JUDGE JEFFERY: The question that I have is, is that an express  
20definition of a calibration process so as to limit the interpretation of that  
21term in the claims to only that particular process?

22 MR. RASHIDI-YAZD: I believe by bringing this definition to the  
23claims it is. I believe we have expressly claimed that the calibration process  
24is three steps. We have invented a step that precedes that. That is using the  
25computer.

26 JUDGE JEFFERY: But the calibration process as claimed "includes"

17Appeal 2007-3134  
18Application 09/746,754  
19

1those three steps?

2 MR. RASHIDI-YAZD: Sure, yes.

3 JUDGE JEFFERY: I mean you didn't say "consisting of" those three  
4steps.

5 MR. RASHIDI-YAZD: Correct, we did not.

6 JUDGE JEFFERY: Nor do I see -- I mean you're not coming out in  
7the specification and saying I define "calibration" as this, I define "initiating  
8the calibration process" as this, whatever it is. I see descriptions. I see just a  
9description of the process. I'll leave it at that. I'm just pointing out the briefs  
10repeatedly mentioned defining these terms and I, frankly, don't see it and  
11unless I'm missing something here, let me know. What I see is a description,  
12however.

13 MR. RASHIDI-YAZD: Well, that said, I think the way that the  
14Examiner -- she is interpreting the initiation of calibration because we're  
15saying calibration is in the prior art. We're not claiming the calibration  
16process itself. I think the initiation stuff is the important part of the crux of  
17our argument, that initiation must occur (indiscernible) the computer.  
18Initiation, as we've defined it -- I think we have adequately defined in our  
19application "initiation." It is that step that projects the GUI onto the  
20whiteboard, and that's why I think the Examiner in this case required that we  
21include the calibration process, identifying 1, 2 and 3 into our claim. So  
22since it's (indiscernible) claim, the calibration process, I think, is -- you  
23know, we're not claiming the calibration process.

24 JUDGE JEFFERY: Well --

25 MR. RASHIDI-YAZD: I'm sorry to interrupt you, but the calibration  
26itself we admit is replete in our --

1 JUDGE JEFFERY: Sure, and they're (indiscernible) claims that --

2 MR. RASHIDI-YAZD: Yes (indiscernible), correct.

3 JUDGE JEFFERY: I wanted to ask you about the cited prior art  
4reference --

5 MR. RASHIDI-YAZD: Yes.

6 JUDGE JEFFERY: -- and the orientation of the whiteboard --

7 MR. RASHIDI-YAZD: Yes.

8 JUDGE JEFFERY: -- is really a key element of this. I take it that  
9Step 1 is not disputed, it can occur at the whiteboard.

10 MR. RASHIDI-YAZD: Yes, it can occur --

11 JUDGE JEFFERY: I can press a button at the whiteboard and I get  
12something happening with respect to the calibration process.

13 MR. RASHIDI-YAZD: Yes, Your Honor. We admit to such I  
14believe both in our appeal brief and our reply brief as such.

15 JUDGE JEFFERY: Yes. Let me ask you one question about the  
16display aspect of that Step 1 --

17 MR. RASHIDI-YAZD: Correct.

18 JUDGE JEFFERY: -- because at the end of the step --

19 MR. RASHIDI-YAZD: Step 1 you're referring to?

20 JUDGE JEFFERY: Just prior to Step 2.

21 MR. RASHIDI-YADI: Yes, sir.

22 JUDGE JEFFERY: You got a display of a dialog box.

23 MR. RASHIDI-YAZD: Yes.

24 JUDGE JEFFERY: Now does that occur at the whiteboard or at the  
25computer or both?

26 MR. RASHIDI-YAZD: We don't know. We don't know. Their prior

1art does not explain such. The Examiner appears to maintain a position that  
2that display, which I would argue would be at the computer, a display of --  
3projection occurs at the whiteboard.

4 JUDGE JEFFERY: Okay. Well, let me just clarify here because in  
5the reply brief on page 8 --

6 MR. RASHIDI-YAZD: Okay. Let me find that.

7 JUDGE JEFFERY: -- you say that -- let me find it here. At the very  
8top on the first -- essentially the first sentence of page 8 on the reply brief  
9you say as part of the manual completing Step 1, which Appellant concedes  
10can occur distant a computer, means the user has still three more steps. So  
11you're saying that completing Step 1 at the whiteboard, which -- somewhere  
12distant the computer, essentially ends prior to the display of the dialog box.

13 MR. RASHIDI-YAZD: Yes, yes.

14 JUDGE JEFFERY: Okay

15 MR. RASHIDI-YAZD: But, again, the prior art does not describe  
16such, so we have to go with what we can read from the 35 pages that we  
17have from the manual. So we classify the art as such, correct.

18 JUDGE JEFFERY: I guess another question that I would pose to you  
19is because we have this open-ended language with respect to the calibration  
20process, why couldn't the calibration process begin at Step 2 of the  
21reference? That is to say Step 2 requires previewing the respective  
22orientation levels. Doesn't that -- is that part of a calibration process, the fact  
23that I'm selecting these options?

24 MR. RASHIDI-YAZD: Where does it occur? They require a click  
25which I would maintain is at the computer.

26 JUDGE JEFFERY: Correct, but the critical issue in the case is the



1initiation of the calibration has to occur distant the computer, right?

2 MR. RASHIDI-YAZD: Yes, sir, correct.

3 JUDGE JEFFERY: What I'm getting at is we've already conceded  
4that Step 1 occurs distant the computer.

5 MR. RASHIDI-YAZD: Correct.

6 JUDGE JEFFERY: There's no dispute there.

7 MR. RASHIDI-YAZD: Yes, no dispute.

8 JUDGE JEFFERY: So if Step 2 is part of the calibration process, then  
9it seems to me we've met the claim. What I'm getting at here is that the  
10claim -- Claim 41 anyway. I'm not necessarily speaking about the other  
11claims.

12 MR. RASHIDI-YAZD: Okay.

13 JUDGE JEFFERY: Claim 41 just merely says the calibration process  
14"includes" these steps.

15 MR. RASHIDI-YAZD: Okay.

16 JUDGE JEFFERY: It doesn't -- there's no closed language here. So  
17why couldn't the calibration process include Step 2?

18 MR. RASHIDI-YAZD: Well, as we were defining the calibration  
19process, the first step of the calibration process we described is the  
20projection of a GUI onto the whiteboard which is Step 5. It's the way that  
21we've defined the calibration process and claim such, design (indiscernible)  
22Step 5.

23 JUDGE JEFFERY: Okay.

24 MR. RASHIDI-YAZD: Moving forward, regarding the independent  
25claims which, as we mentioned in our reply brief, that the Examiner failed to  
26explain any of his allegations on why they should be rejected. He came back

1with a -- assuming that now Your Honor does not allow or believe that 41 is  
2allowable -- we think at least remote control device such that initiating the  
3calibration process distant the computer is not taught by the prior reference.

4 JUDGE JEFFERY: Why couldn't a button on the whiteboard be a  
5remote control device, at least with respect to functions with respect to the  
6computer? I mean if I click on the whiteboard either with my finger or I  
7push a button, whatever, isn't that controlling a process remotely with  
8respect to the computer?

9 MR. RASHIDI-YAZD: I would argue it could, but I don't think in  
10this case -- the remote control device, I think, would be the reasonable  
11interpretation of a remote control device. It would not fall underneath that  
12umbrella.

13 JUDGE MARTIN: You want us to construe that to mean a handheld  
14remote control?

15 MR. RASHIDI-YAZD: Yes. Do you have any further questions or  
16shall I continue?

17 JUDGE MARITN: No. Actually that's all we have. Okay. No  
18further questions.

19 MR. RASHIDI-YAZD: All right. As the Appellant's counsel, we  
20thank you for your time.

21 JUDGE MARTIN: Thank you. That concludes the hearing in Appeal  
222007-3134.

23(Whereupon, the proceedings concluded.)